

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 58

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EARL R. ERNSBERGER

Appeal No. 2002-0726
Application No. 08/606,762

HEARD: March 4, 2003

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4-6, 8, 10, 11, 18, 19 and 23-25. Claims 7, 12, 15, 17¹ and 20 have been indicated as containing allowable subject matter, and claims 3, 9, 13, 14, 16, 21 and 22 have been canceled.

We REVERSE.

¹Claim 17 was not listed by the examiner as containing allowable subject matter. However, this apparently is an inadvertent omission, in that claim 17 depends from claim 12, which was so listed.

BACKGROUND

The appellant's invention relates to a trap for luring and retaining insects (claims 1, 2, 4-6, 8, 10 and 11), to a kit for luring and retaining insects into a trap (claims 18 and 19) and to a method for luring and retaining insects into a trap (claims 23-25). An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rutherford	2,046,430	Jul. 7, 1936
Carle (PCT Application)	WO 94/19938	Sep. 15, 1994

Claims 1, 2, 4-6, 8, 10, 11, 18, 19 and 23-25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Carle in view of Rutherford.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 49) and the final rejection (Paper No. 42) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 47) and Reply Brief (Paper No. 51) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The appellant's invention comprises a hollow housing and a hollow cartridge member positioned within the housing . The examiner finds that all of the subject matter recited in independent claims 1, 10, 18 and 23 is disclosed or taught by Carle except for an insect luring means positioned within the cartridge member. However, the

examiner takes the position that it would have been obvious to one of ordinary skill in the art to modify the Carle trap by additionally placing an insect luring means in the cartridge member, in view of the teaching of Rutherford. The appellant argues in rebuttal that there exists no suggestion which would have motivated one of ordinary skill in the art to do so. We find ourselves in agreement with the appellant. Our reasoning follows.

The Carle insect trap comprises a hollow housing 1 within the bottom of which is a hollow cartridge member 17 in the form of a drawer. A conical member 41 provides an opening in one side of the housing. A suction fan 37 is so positioned as to draw insects into the trap through the conical member and thereafter through the attached horizontal conduit 43 and vertical conduit 52, and then into cartridge 17 (see Figure 3). To lure insects to the trap and into the suction zone of the fan, Carle positions a light bulb 49 in the conical opening. Thus, while Carle discloses an insect luring means, it is not positioned in the cartridge, as is required by the appellant's claims.

Rutherford discloses an insect trap comprising an inverted truncated cone 8 to the top of which is attached a funnel 13 terminating in a spout 12 that extends into the top of the truncated cone. The bottom of the truncated cone is closed by a floor member in the form of a removable screen 2. The screen is covered with sticky paper to which the trapped insects become adhered, and a quantity of bait 6 also is provided in a bait holder located on the screen. Thus, insects attracted to the bait pass

downwardly through the funnel into the truncated cone, where they become adhered to the floor.

The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Carle has a light to attract insects into the inlet of the trap to the point where they can be drawn into the trap by the suction fan. This being the case, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to provide the Carle trap with a second insect lure located in the cartridge, for it would seem to have no purpose; by the time insects reach the Carle cartridge they already have been lured into the trap and have been caused to enter the cartridge by the suction of the fan. We are not persuaded otherwise by the examiner's reasoning that more insects would have been attracted to the trap if the proposed modification were made, considering that no evidence has been provided in support of this conclusion.

It therefore is our opinion that the combined teachings of Carle and Rutherford fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 1, 10, 18 and 23, and we will not sustain the rejection of these claims or of dependent claims 2, 4-6, 8, 11, 19, 24 and 25..

CONCLUSION

The rejection is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS
Administrative Patent Judge

CHARLES E. FRANKFORT
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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